UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,718	11/10/2003	Tetsuo Seto	003797.00711	5005

28319	7590	04/17/2006

BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET , N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER
NGUYEN, CAO H

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	10/705,718	SETO ET AL.
	Examiner	**Art Unit**	
	Cao (Kevin) Nguyen	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 January 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

. DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. A tool for associating characters non-statutory is not qualified

for useful process and machine. The tool is not apparatus, it is a program per se. It is not

embodied tangibly throughout it has a tangible result. It is not in itself tangible. Appropriate

correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person · having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various ·

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yin (US Patent No. 4,980,840) in view of Kaji et al. (US Patent No. 5,526,259).

Regarding claim 1, Yin discloses tool for associating characters, comprising a segmentation module that associates two or more characters into a segment [..character display sub-module English and Chinese; see col. 14, lines 1-53]; however, Yin fails to explicitly teach a user interface that allows a user to designate the segmentation of characters by the segmentation module.

Kaji discloses a user interface that allows a user to designate the segmentation of characters by the segmentation module (see col. 9, lines 10-40). It would have been obvious to one of an ordinary skill in the art, having the teaching of Yin and Kaji before him at the time the invention was made, to provide a user interface that allows a user to designate the segmentation of characters by the segmentation module of Kaji to include a word segmentation method to identify proper names, as taught by Yin. One would have been motivated to make such a combination in order to provide a word segmentation refers to the process of identifying individual words that conversion an expression of language.

Regarding claim 2, Kaji discloses wherein the user interface displays a plurality of characters, and provides an indicator indicating which of the plurality of characters are associated together into the segment (see col. 9, lines 41-65).

Regarding claim 3, Kaji discloses wherein, the indicator can be modified by a user to change which characters are associated together into the segment (see col. 9, lines 1-61).

Regarding claim 4, Kaji disclose wherein the indicator appears as a bar running adjacent to characters associated together into the segment; and the user can extend the bar to add characters to the segment (see col. 15, lines 1-39).

Regarding claim 5, Kaji disclose wherein the indicator appears as a bar running adjacent to characters associated together into the user can contract the bar to remove characters from the segment (see col. 15, lines 40-65).

Regarding claim 6, Yin disclose wherein the user interface provides a menu command that allows a user to designate the segmentation of characters by the segmentation module (see col. 15, lines 10-65).

Regarding claim 7, Kaji disclose wherein the user interface displays a second indicator indicating which of the plurality of characters associated together into a second segment (see col. 20, lines 1-50).

Regarding claim 8, Kaji discloses wherein the user interface displays a plurality of characters on two or more lines, and provides an indicator that indicates which of the plurality of characters are associated together into the can be modified by a user to change associate one or more of lines characters on segment, and different lines together into the segment (see col. 24, lines 5-53).

Regarding claim 9, Kaji discloses wherein the user interface provides a menu command that allows a user to designate the segmentation of characters by the segmentation module (see 26, lines 1-32).

Regarding claim 10, Yin discloses further comprising an electronic ink recognition module for recognizing at least one of the characters from electronic ink (see col. 23, lines 1-25).

Claim 11 differs from claim 1 in that "a tool for converting characters of a first type into characters of a second type, a segmentation module that associates two or more characters of the first type into a user interface that allows a user to designate the segmentation of characters by segmentation module, and a character conversion module that converts the characters of the segment into at least one character of the second type" which read on Kaji (see col. 14, lines 15-59). It would have been obvious to one of an ordinary skill in the art, having the teaching of Yin and Kaji before him at the time the invention was made, to provide a tool for converting characters of Kaji to include a word segmentation method to identify proper names, as taught by Yin. One would have been motivated to make such a combination in order to provide a word segmentation refers to the process of identifying individual words that conversion an expression of language.

Regarding claim 12, Kaji discloses wherein the user interface displays a plurality of characters; and provides an indicator indicating which of the plurality of characters are associated together into the segment (see col. 20, lines 1-50).

Regarding claim 13, Kaji discloses wherein the indicator can be modified by a user to change which characters are associated together into the segment (see col. 22, lines 4-51).

Regarding claim 14, Yin discloses where the indicator appears as a bar running adjacent to characters associated together into the segment; and the user can extend the bar to add characters to the segment (see figures 5A-6).

As claims 15-20 are analyzed as previously discussed with respected to claims 1-14 above.

Claim 21 differ from claims 1 and 11 in that "providing an indicator that associates a first group of the plurality of characters into a segment, receiving input modifying the indicator to associate a second group of the plurality of characters into the segment" which read on Yin (see col. 8, lines 8-62).

Regarding claim 22, Yin discloses wherein the second group includes the first group and additional characters (see figure 34).

Regarding claim 23, Yin discloses wherein the second group includes only a portion of the first group of characters (see figures 32-34).

Regarding claim 24, Kaji discloses wherein the indicator is a bar adjacent to the first group of characters; and the input changes a length or position of the bar so that the bar is adjacent to the second group of characters (see col. 8, lines 20-62).

Regarding claim 25, Kaji discloses, further including displaying the first group of characters on a first line; displaying a first portion of the second group of characters on the first line; displaying a second portion of the second group of characters on a second line; and receiving input that modifies the indicator to extend from the first line to the second (see col. 11-12).

Response to Arguments

Applicant's arguments filed 01/31/06 have been fully considered but they are not persuasive.

On page 2 of the Remark, Applicant state that "a tool for associating characters may be implemented by a programmable computer" from specification. However, the claim does not represent the distinction a tool for associating characters may be implemented by a programmable computer. Therefore, the tool is not apparatus, it is a program per se. It is not embodied tangibly throughout it has a tangible result. It is not in itself tangible.

In response to applicant's argument that on pages 3 there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yin discloses tool for associating characters used in combination of Kaji's segmentation of characters by the segmentation module. One would have been motivated to make such a combination in order to provide a word segmentation refers to the process of identifying individual words that conversion an expression of language, and allowing a user to convert one or more phonetic characters into a phrase containing a pictographic character.

In response to applicant's argument that the combination of Yin and Kaji do not teach or suggest a user interface that allows a user to designate the segmentation of characters, the fact that applicant has recognized another advantage which would flow naturally from following the

suggestion of the prior art cannot be the basis for patentability when the differences would

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that Yin and Kaji do not teach or suggest a user to designate the

segmentation of phonemes or words through a user interface. The examiner respectfully

disagrees. As shown in figures 5B, Yin teaches a character library and character generating

system, a display, an editing and composing process device and peripheral devices, and

automatically processes the corresponding text while providing the user with a simple and

convenient operational interface with inputting and editing, as recited in abstract. Therefore, it

would have been obvious to combine the teachings of Yin and Kaji in order to receive the

characters and commands from the I/O interface; the received characters are manipulated under

the control of the computer unit.

Applicant argues that Yin and Kaji do not teach or suggest providing an indicator that

associates a first group of the plurality of characters into a segment, receiving input modifying

the indicator to associate a second group of the plurality of characters into the segment . The

examiner respectfully disagrees. As shown in figures 5B, Yin teaches a word is picked out or

"assembled" starting at the position which is indicated by the current position indicator for

source text in the source text, and the bilingual dictionary is retrieved using the picked-out

or assembled word as a key . When the retrieval succeeds, the target language information (the

phonetic expression and the character expression in the retrieved record is registered in the

storage area of the candidate words composing the translation text, the current position indicator

for source text is updated so that it indicates the top position of the next word, the processing is

returned to the word segmenting processing from the source text; as recited in column 8, lines

33-62 and col. 9, lines 10-65. Therefore, one would have been motivated to make such a

combination in order to provide a word segmentation refers to the process of identifying

individual words that conversion an expression of language, and allowing a user to convert one

or more phonetic characters into a phrase containing a pictographic character.

Accordingly, the claimed invention as represented in the claims does not represent a

patentable distinction over the art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. (see PTO-892).

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

04/15/06